

REMARKS

These remarks and the above amendments are responsive to the Office Action dated November 28, 2003 and support the accompanying Request for Continued Examination as a submission under 37 C.F.R. § 1.114(c). Claims 36-58 are pending in the application. In the Office Action, the Examiner rejected claims 36-58 under 35 U.S.C. § 112, first paragraph, as being nonenabled by the specification. None of the claims was rejected in view of prior art. Applicants traverse the rejections. Applicants contend that the rejected claims are enabled. Nevertheless, to reduce the number of issues under consideration, and to expedite the issuance of a patent, applicants have amended claims 36, 45, 47, 48, 53, and 55, and added new claims 59 and 60. Accordingly, in view of these amendments and their Request for Continued Examination, applicants respectfully request reconsideration of the rejected claims, and prompt issuance of a notice of allowance.

I. Request for Continued Examination

Applicants are submitting herewith a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. This Request complies with the requirements of 37 C.F.R. § 1.114. In particular:

- (i) Prosecution in the application is closed, since the last Office action was a final Office action under 37 C.F.R. § 1.113.
- (ii) The Request is accompanied by a submission as set forth at 37 C.F.R. § 1.114(c), specifically, the amendments, remarks, and arguments set forth herein.
- (iii) The Request is accompanied by the fee set forth at 37 C.F.R. § 1.17(e).

Accordingly, applicants respectfully request grant of their Request for Continued Examination.

II. Claim Rejections – 35 U.S.C. § 112

The Examiner rejected claims 36-58 under 35 U.S.C. § 112, first paragraph, as being nonenabled by the specification. In particular, the Examiner stated that while the specification is enabling for the generation or consumption of cyclic nucleotides by a cyclase or phosphodiesterase enzyme, the specification does not provide enablement for any other enzymes or reaction, and therefore does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with the claims.

Applicants disagree, suggesting that the Examiner has misconstrued the scope of the claims, in that the pending claims do not recite, for example, the identification of reactions that generate or consume cyclic nucleotides. Rather, the claims recited the identification of modulators for such reactions, as described and fully enabled by the specification for one of skill in the art.

However, in the interest of furthering prosecution of the application, applicants have amended claim 36 to recite a method of identifying a compound as a modulator of G-protein-linked receptor activity that generates or consumes a cyclic nucleotide through the action of a cyclase or phosphodiesterase.

The Examiner has previously stated that the specification is enabling for “an in vitro method of measuring the generation or consumption of cyclic nucleotide by an enzyme selected from the group consisting of cyclases, phosphodiesterases, in the presence and absence of test compounds via the detection of polarization of emitted

light.” Applicants therefore respectfully suggest that claims 36-60 are enabled by the specification, and request the withdrawal of the rejection of those claims under 35 U.S.C. § 112, first paragraph.

III. Claim Amendments

Applicants have amended claims 36, 45, 47, 48, 53, and 55, and added new claims 59 and 60, as noted above.

Support for the amendments to claim 36 may be found in the specification generally at Figure 2; page 5, line 16 to page 9, line 17; and page 15, lines 2-5; and in claims 7-12, as originally filed.

The amendments to claims 45, 47, 48, 53, and 55 are intended to provide consistency with the language of claim 36.

Support for new claims 59 and 60 may be generally found in the specification at page 7, lines 5-19; page 16, lines 10-18; and at Example 3 (page 26).

Applicants reserve their right to pursue claims to general methods of identifying modulators of reactions that generate or consume cyclic nucleotides in continuation applications.

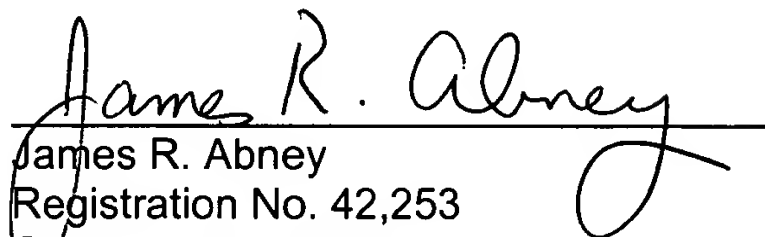
IV. Conclusion

Applicants believe that they have addressed all of the issues raised by the Examiner in the Office action, and that the application currently is in condition for allowance. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowance covering the claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, the Examiner is

encouraged to call applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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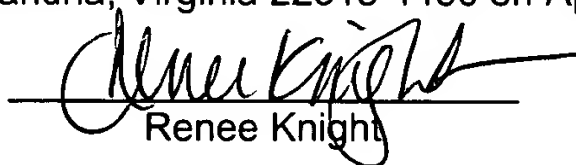
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on April 28, 2004.


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